

corresponding language reads (with added reference numerals), “the straightening element 14 being connected to the casing 11 at the guidewire exit point 22” and “the aperture 25 being located between the outlet of the casing 11 and the tube portion of the straightening element 14”. FIG. 3 of the application and the patent are the same and clearly show that the “guidewire exit point 22” and the “outlet of the casing 11” differ, as do “the tube portion” and “the guidewire exit point 22” of the straightening element 14. Thus, when the reading the claims as a whole in light of the specification (including FIG. 3 of the drawings and the paragraph bridging application pages 6 and 7), it is clear that the two documents do not describe the same point of connection between the straightening element 14 and the casing 11, nor do the two documents describe the same location of the aperture 25.

The Examiner rejects for statutory double patenting application Claim 25 based on Claim 1 of U.S. Patent No. 5,448,993. The allegation of the Examiner that application Claim 1 and patent Claim 1 are “similar in scope” is totally without justification; only one of these claims is limited to one-handed operation of the device. The Examiner ignores the clear limitation of the method of application Claim 25, in both the preamble and the body of the claim, to the use of “only one hand.” MPEP § 804 II.A. states “a reliable test for double patenting under 35 U.S.C. § 101 is whether [one] claim could be literally infringed without literally infringing a corresponding claim in the [other]. . . Is there an embodiment of the invention that falls within the scope of one claim, but not the other?” In the present instance a two-handed method of operation would clearly infringe the patent claim, but not the application claim.

The Examiner further bases the double patenting rejection on the allegation that “the claim merely recalls the feature of the product claim and the method steps are merely using the device that is inherent from the device.” The reference to what a claim “recalls” and the use of

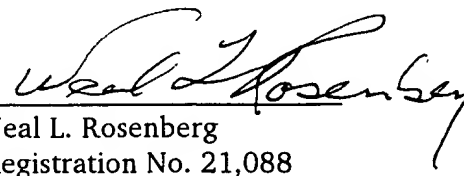
the doctrine of inherency are both foreign to the statutory double patenting rule (which is based on Section 101) and suggests rather doctrines of patentability under Sections 102 and 103 (relating to anticipation and obviousness). There is no basis in the law for the "merely" standards applied by the Examiner.

In view of the above amendments and remarks, reconsideration of the rejection and allowance of all claims is respectfully requested.

If an extension of time is required to enable this document to be timely filed and there is no separate Request for Extension of Time, this document is to be construed as also constituting a Request for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed. Any fee required for such a Request for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17 and not submitted herewith should be charged to the Deposit Account of the undersigned attorneys, Account No. 01-1785; any refund should be credited to the same account. One copy of this document is enclosed.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN  
Attorneys for Applicant  
90 Park Avenue  
New York, New York 10016  
(212) 697-5995

By:   
Neal L. Rosenberg  
Registration No. 21,088

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